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10/804,616	03/19/2004	Alex J. Simmons	60001.0302US01/MS302497.1	7864

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Christopher J. Leonard
Merchant & Gould P.C.
P.O. Box 2903
Minneapolis, MN 55402-0903

EXAMINER

PHAN, TIEN P

ART UNIT	PAPER NUMBER
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2609

MAIL DATE	DELIVERY MODE
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07/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/804,616

Applicant(s)

SIMMONS, ALEX J.

Examiner

Tien Phan

Art Unit

2609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19/03/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwema et al. (US PGPub US2004/0021701a1), in view of Microsoft Word.

As to claim 1, Iwema et al. discloses a method of automatically adjusting the electronic ink height of an electronic highlighter device, comprising: the use of an the electronic pen for functioning as an electronic highlighter device (See Fig. 5; page 5, paragraphs 0055); engaging the electronic pen with a computer-displayed object (See Fig. 5; page 6, paragraphs 0056). Accordingly, Iwema et al. does not expressly teach the determining the height of the computer-displayed object; and setting the electronic ink height of the electronic pen to the determined height.

However, Microsoft Word teaches the method of determining the height of the computer-displayed object (See Fig. 1 and 2; when selecting the object (Test) using the mouse, the font size will be displaced in the font box); Microsoft Word discloses the setting the electronic ink height by using the mouse to determine the height of the object (See Fig. 1 and 2). Therefore, it would have been

obvious to a person of ordinary skill in the art at the time of the invention to utilize the electronic pen in the system of Iwema et al., in view of the teaching in the Microsoft Word reference, because the motivation for modifying the references or to combine the reference teachings would have enabled the electronic pen to function as a highlighter device to edit, replace or show the size of the object for formatting.

As to claim 2, Iwema et al. discloses the engaging the electronic highlighter pen with a computer-displayed object includes engaging the electronic highlighting device with a computer-displayed text selection (See Fig. 3; page 5, paragraphs 0054).

As to claim 3, Iwema et al. discloses the computer-displayed text selection includes a typed text selection (See Fig. 3; page 5, paragraphs 0051).

As to claim 4, Iwema et al. discloses the computer-displayed text selection includes a handwritten text selection (See Fig. 3; page 5, paragraphs 0051).

As to claim 5, Iwema et al. discloses the engaging the electronic highlighter pen with a computer-displayed object includes engaging the electronic highlighter device with a computer-displayed image (See Fig. 3; page 5, paragraphs 0054).

As to claim 6, Iwema et al. discloses the engaging the electronic highlighter device with a computer-displayed object includes touching a tip of the electronic pen to the computer-displayed object (See Fig. 3; page 5, paragraphs 0051).

As to claim 7, Iwema et al. discloses the engaging the electronic highlighter device with a computer-displayed object includes touching a tip of the electronic pen to the computer-displayed text selection (See Fig. 3; page 5, paragraphs 0051).

As to claim 8, Iwema et al. discloses the touching a tip of the electronic pen to a computer-displayed text selection includes touching a tip of the electronic pen to a computer-displayed typed text selection (See Fig. 3; page 5, paragraphs 0051).

As to claim 9, Iwema et al. discloses the touching a tip of the electronic pen to a computer-displayed text selection includes touching a tip of the electronic pen to a computer-displayed handwritten text selection (See Fig. 3; page 5, paragraphs 0051).

As to claim 10, Iwema et al. discloses the touching a tip of the electronic pen to a computer-displayed text selection includes touching a tip of the electronic pen to a computer-displayed typed image (See Fig. 3; page 5, paragraphs 0051).

As to claim 11, Microsoft Word discloses the determining the height of the computer-displayed object includes determining the height of a computer-displayed text selection (See Fig. 1 and 2; when selection of the object is made, the height of the object is displayed in the font size box). In addition, the same motivation is used as the rejection for claim 1.

As to claim 12, Microsoft Word discloses the determining the height of the computer-displayed text selection includes determining the height of a computer-displayed typed text selection (See Fig. 1 and 2; when selection of the typed text is made, the height of the typed text is displayed in the font size box). In addition, the same motivation is used as the rejection for claim 1.

As to claim 13, Microsoft Word discloses the determining the height of the computer-displayed typed text selection includes determining the height of the computer-displayed text selection based on a font size of the computer-displayed typed text selection (See Fig. 1 and 2; when selection of the typed text is made, the height is determined of the typed text is displayed in the font size box). In addition, the same motivation is used as the rejection for claim 1.

As to claim 14, Iwema et al. discloses determining the height of the computer-displayed text selection includes determining the height of a computer-displayed handwritten text selection (See Page 7; paragraphs 0068).

As to claim 15, Iwema et al. discloses determining the height of a computer-displayed handwritten text selection includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection (See Page 3, paragraphs 0037).

As to claim 16, Iwema et al. discloses determining the height of the computer-displayed handwritten text selection includes determining the height of

the computer-displayed handwritten text selection based on the maximum height of the computer-displayed handwritten text selection including the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection (See Fig. 5; page 6, paragraph 0059).

As to claim 18, Microsoft Word discloses the distributing of electronic ink at the determined height onto the computer-displayed object (See Fig. 1 and 2; when setting the font size in the font size box, then the electronic ink can be distributed at the determined height). In addition, the same motivation is used as the rejection for claim 1.

As to claim 19, Iwema et al. discloses the selecting an electronic pen for functioning as an electronic highlighter device includes selecting an electronic mousing device for functioning as an electronic highlighter device (See Fig.5; page 6, paragraph 0056); and whereby engaging the electronic pen with a computer-displayed object includes focusing a cursor of the electronic mousing device over the computer-displayed object and clicking the electronic mousing device for distributing electronic ink onto the computer-displayed object (See Fig.5; page 6, paragraph 0059).

3. Claim 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Iwema et al. (US PGPub US2004/0021701a1) to Microsoft Word, in further view of Lui (US Patent 6,683,600 B1).

As to claim 17, claim limitation according to claim 11 are met by Iwema et al. and Microsoft Word, in further view of Lui (US Patent 6,683,600 B1). Lui discloses if the computer-displayed text selection is displayed on a computer-generated display having rule lines, determining the height of the computer-displayed text selection to be the distance between a pair of rule lines displayed on the computer-generated display (See Fig. 4; column 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize Lui teaching, because the motivation for modifying the references or to combine the reference teachings would have given electronic pen the capability as a highlighter device to function in different modes for formatting between the pair of rule lines.

4. Claim 20-42 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwema et al. (US PGPub US2004/0021701a1), in view of Microsoft Word.

As to claims 20, Iwema et al. discloses a method of automatically adjusting the electronic ink height of an electronic highlighter device, comprising: selecting an electronic input device for functioning as an electronic highlighter device (See Fig. 5, page 5, paragraphs 0055, line 1-18); engaging the electronic highlighter device with a computer-displayed object (See Fig. 5; page 6, paragraphs 0056); Accordingly, Iwema et al. does not expressly teach the determining the height of the computer-displayed object; and setting the electronic ink height of the electronic pen to the determined height.

However, Microsoft Word teaches the method of determining the height of the computer-displayed object (see Fig. 1 and 2; when selecting the object (Test) using the mouse, the font size will be displaced in the font box); Microsoft Word discloses the setting the electronic ink height by using the mouse to determine the height of the object (see Fig. 1 and 2). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the electronic input device in the system of Iwema et al., in view of the teaching in the Microsoft Word reference, because the motivation for modifying the references or to combine the reference teachings would have enabled the electronic pen to function as a highlighter device to edit, replace or show the size of the object for formatting.

As to claim 21, Iwema et al. discloses the engaging the electronic highlighter device with a computer-displayed object includes engaging the electronic highlighting device with a computer-displayed text selection (See Fig. 3; page 5, paragraphs 0054).

As to claim 22, Iwema et al. discloses the computer-displayed text selection includes a typed text selection (See Fig. 3; page 5, paragraphs 0051).

As to claim 23, Iwema et al. discloses the computer-displayed text selection includes a handwritten text selection (See Fig. 3; page 5, paragraphs 0051).

As to claim 24, Iwema et al. discloses the engaging the electronic highlighter pen with a computer-displayed object includes engaging the electronic

highlighter device with a computer-displayed image (See Fig. 3; page 5, paragraphs 0054).

As to claim 25, Iwema et al. discloses the electronic highlighter device includes an electronic pen (See Fig. 5; page 5, paragraphs 0055).

As to claim 26, Iwema et al. discloses the engaging the electronic highlighter device with a computer-displayed object includes touching a tip of the electronic pen to the computer-displayed object (See Fig. 3, page 5, paragraphs 0051, line 9-13).

As to claim 27, Iwema et al. discloses the engaging the electronic highlighter device with a computer-displayed object includes touching a tip of the electronic pen to the computer-displayed text selection (See Fig. 3; page 5, paragraphs 0051).

As to claim 28, Iwema et al. discloses the touching a tip of the electronic pen to a computer-displayed text selection includes touching a tip of the electronic pen to a computer-displayed typed text selection (See Fig. 3; page 5, paragraphs 0051).

As to claim 29, Iwema et al. discloses the touching a tip of the electronic pen to a computer-displayed text selection includes touching a tip of the electronic pen to a computer-displayed handwritten text selection (See Fig. 3; page 5, paragraphs 0051).

As to claim 30, Iwema et al. discloses the touching a tip of the electronic pen to a computer-displayed text selection includes touching a tip of the

electronic pen to a computer-displayed typed image (See Fig. 3; page 5, paragraphs 0051).

As to claim 31, Iwema et al. discloses the electronic highlighter device includes an electronic mousing device (See Fig. 5; page 6, paragraphs 0056).

As to claim 32, Microsoft Word discloses engaging the electronic highlighter device with a computer-displayed object includes focusing a mousing device cursor on the computer-displayed object (See Fig. 1 and 2; it will be appreciated that the object is highlighted by the mousing cursor); and clicking the mousing device (See Fig. 1 and 2; it will be appreciated that by clicking the mouse would highlight the object). In addition, the same motivation is used as the rejection for claim 1.

As to claim 33, Microsoft Word discloses the focusing mousing device cursor on the computer-displayed object includes focusing the mousing device cursor on a computer-displayed text selection (See Fig. 1 and 2; it will be appreciated that the text is highlighted by the mousing cursor). In addition, the same motivation is used as the rejection for claim 1.

As to claim 34, Microsoft Word discloses the focusing of mousing device cursor on the computer-displayed object includes focusing the mousing device cursor on a computer-displayed typed text selection (See Fig. 1 and 2; it will be appreciated that the typed text is highlighted by the mousing cursor). In addition, the same motivation is used as the rejection for claim 1.

As to claim 35, Iwema et al. discloses the focusing of mousing device cursor on the computer-displayed text selection includes focusing the mousing device cursor on a computer-displayed handwritten text selection (See Fig. 5; page 6, paragraph 0059).

As to claim 36, Microsoft Word discloses the focusing of mousing device cursor on the computer-displayed object includes focusing the mousing device cursor on a computer-displayed image (See Fig. 1 and 2; it will be appreciated that the image is highlighted by the mousing cursor). In addition, the same motivation is used as the rejection for claim 1.

As to claim 37, Microsoft Word discloses the determining the height of the computer-displayed object includes determining the height of a computer-displayed text selection (See Fig. 1 and 2; it will be appreciated the correct size or height of the object or text being highlighted). In addition, the same motivation is used as the rejection for claim 1.

As to claim 38, Microsoft Word discloses the determining the height of the computer-displayed text selection includes determining the height of a computer-displayed typed text selection (See Fig. 1 and 2; it will be appreciated the correct size or height of the text or typed text being highlighted). In addition, the same motivation is used as the rejection for claim 1.

As to claim 39, Microsoft Word discloses the determining the height of the computer-displayed typed text selection includes determining the height of the computer-displayed text selection based on the font size of the computer-

displayed typed text selection (See Fig. 1 and 2; it will be appreciated the correct size or height of the object or text being highlighted base on the font size box).

As to claim 40, Iwema et al. discloses the determining the height of the computer-displayed text selection includes determining the height of a computer-displayed handwritten text selection (See Fig. 5; page 6, paragraph 0059). In addition, the same motivation is used as the rejection for claim 1.

As to claim 41, Iwema et al. discloses the determining the height of a computer-displayed handwritten text selection includes determining an average height of the computer-displayed handwritten text selection without considering the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection (See Fig. 10; page 6, paragraph 0059).

As to claim 42, Iwema et al. discloses the determining the height of the computer-displayed handwritten text selection includes determining the height of the computer-displayed handwritten text selection based on the maximum height of the computer-displayed handwritten text selection including the length of any ascending or any descending character segments of any characters comprising the computer-displayed handwritten text selection (See Fig. 10; page 6, paragraph 0059).

As to claim 44, Microsoft Word discloses the distributing of electronic ink at the determined height onto the computer-displayed object (See Fig. 1 and 2; when setting the font size in the font size box, then the electronic ink can be

distributed at the determined height). In addition, the same motivation is used as the rejection for claim 1.

5. Claim 43 rejected under 35 U.S.C. 103(a) as being unpatentable over Iwema et al. (US PGPub US2004/0021701a1) to Microsoft Word, in further view of Lui (US Patent 6,683,600 B1).

As to claim 43, claim limitation according to claim 37 are met by Iwema et al. and Microsoft Word, further in view of Lui (US Patent 6,683,600 B1). Lui discloses if the computer-displayed text selection is displayed on a computer-generated display having rule lines, determining the height of the computer-displayed text selection to be the distance between a pair of rule lines displayed on the computer-generated display (See Fig. 4; column 7, line 5-26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize Lui teaching, because the motivation for modifying the references or to combine the reference teachings would have enabled to show the correct height of the computer-displayed text selection to be the distance between the pair of rule lines.

6. Claim 45-47 rejected under 35 U.S.C. 103(a) as being unpatentable over Iwema et al. (US PGPub US2004/0021701a1), further in view of Microsoft Word.

As to claims 45, Iwema et al. discloses a computer-readable medium containing computer-executable instructions which when executed by a computer automatically adjust the electronic ink height of an electronic highlighter device, comprising: selecting an electronic pen for functioning as an electronic highlighter

device (See Fig. 5; page 5, paragraphs 0055); engaging the electronic pen with a computer-displayed object (See Fig. 5; page 6, paragraphs 0056). Accordingly, Iwema et al. does not expressly teach the determining the height of the computer-displayed object; and setting the electronic ink height of the electronic pen to the determined height.

However, Microsoft Word teaches the method of determining the height of the computer-displayed object (see Fig. 1 and 2; when selecting the object (Test) using the mouse, the font size will be displaced in the font box); Microsoft Word discloses the setting the electronic ink height by using the mouse to determine the height of the object (see Fig. 1 and 2). Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the electronic pen in the system of Iwema et al., in view of the teaching in the Microsoft Word reference, because the motivation for modifying the references or to combine the reference teachings would have enabled the electronic pen to function as a highlighter device to edit, replace or show the size of the object for formatting.

As to claim 46, Microsoft Word discloses the distributing of electronic ink at the determined height onto the computer-displayed object (See Fig. 1 and 2; when setting the font size in the font size box, then the electronic ink can be distributed at the determined height). In addition, the same motivation is used as the rejection for claim 1.

As to claim 47, Iwema et al. discloses the selecting an electronic pen for functioning as an electronic highlighter device includes selecting an electronic mousing device for functioning as an electronic highlighter device (See Fig.5; page 6, paragraph 0056); and whereby engaging the electronic pen with a computer-displayed object includes focusing a cursor of the electronic mousing device over the computer-displayed object and clicking the electronic mousing device for distributing electronic ink onto the computer-displayed object (See Fig.5; page 6, paragraph 0059).

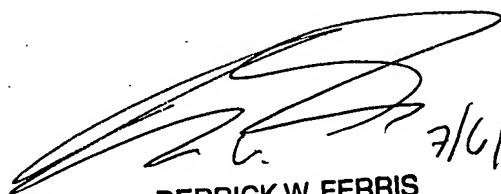
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tien Phan whose telephone number is 571 270 3309. The examiner can normally be reached on Monday-Friday 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derrick Ferris can be reached on 571 272 3123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2609

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



7/6/02
DERRICK W. FERRIS
SUPERVISORY PATENT EXAMINER